

REMARKS

In the Final Office Action of October 8, 2003, the Examiner rejected claims 1-5 as being obvious over *Covalesski* in view of *Kolesov et al.* The Examiner also rejected claims 1 and 3-5 as being obvious over *Arai* in view of *Kolesov et al.* In light of a recently obtained English translation of *Kolesov et al.*, Applicants respectfully submit that the Examiner has not made out a *prima facie* case of obviousness because *Kolesov et al.* fails to disclose a "soluble amorphous substance."

In her Final Office Action of October 8, 2003, the Examiner stated: "While the reference [*Kolesov et al.*] teaches that the beads are chemically inert and non-soluble in water and hydrocarbons, since these contain the same components as claimed herein, these are considered soluble as defined by Applicant. Therefore, the Examiner equates the chemical composition above to the claimed amorphous substance." Detailed Action at 4-5. Applicants respectfully submit that this statement is incorrect when the entirety of *Kolesov et al.* is considered, particularly because the components in *Kolesov et al.* are significantly larger than the claimed components.

In the complete publication of *Kolesov et al.*, attached hereto, a chart indicates the sizes of the disclosed ellipsoidal beads. "C" on the chart is the larger semi-axis and "d" is the smaller semi-axis. According to the chart, "C" may be 0.04-0.08 centimeters, or 400-800 μm . The chart discloses a range for "d" from 0.026-0.053 centimeters, or 260-530 μm .

In contrast, Applicants' specification teaches that the "[f]ibers of the soluble amorphous substance according to the present invention have an average fiber diameter in a range from 2 μm to 9 μm , preferably in a range of from 3 μm to 6 μm ."

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Applicants' specification, page 7, lines 1-4. Further, "[g]rains of the soluble amorphous substance according to the present invention have an average grain size in a range of from 2 μm to 100 μm , preferably in a range of from 5 μm to 30 μm ." Applicants' specification, page 7, lines 19-22.

As shown, there is a great difference in size between the components disclosed in *Kolesov et al.* and those taught in Applicants' specification. One of ordinary skill in the art knows that particle size affects solubility. In light of this knowledge, Applicants respectfully submit that the Examiner has failed to show that the components disclosed in *Kolesov et al.* are soluble as required by the claims. The Examiner was therefore incorrect to equate the chemical composition of *Kolesov et al.* with the claimed soluble amorphous substance. Further, maintaining this rejection would ignore the admission in the reference that the disclosed components are "insoluble in water and hydrocarbon compounds." English translation of *Kolesov et al.*, col. 3, lines 13-14. Thus, the claims are not obvious because *Kolesov et al.*, taken alone or in combination with the cited references, does not disclose, teach, or suggest the claimed invention.

Applicants also bring to the Examiner's attention that Table 1 has been amended to correct an inaccuracy that appeared through a clerical error without deceptive intent. Example 3 should indicate a 20 wt% barium sulfate content, not 45 wt%. Applicants believe this amendment does not introduce new matter or require a new search.

Conclusion

In view of the foregoing remarks, Applicants submit that this claimed invention is neither anticipated nor rendered obvious in view of the prior art references cited against

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this application. Applicants therefore request the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Attachments:

- 1) *Kolesov et al.* (SU 1740396 A1)
- 2) English-language translation of *Kolesov et al.*

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